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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,408	02/26/2004	Kiyoshi Miyazaki	52012/DBP/A400	6124
23363	7590	03/08/2005	EXAMINER	
CHRISTIE, PARKER & HALE, LLP			BELL, KENT L	
PO BOX 7068			ART UNIT	
PASADENA, CA 91109-7068			PAPER NUMBER	

1661

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/789,408	Applicant(s) MIYAZAKI ET AL.	
	Examiner Kent L. Bell	Art Unit 1661	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on application filed 2/26/04.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 2/26/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/22/04 + 2/26/04</u> | 6) <input type="checkbox"/> Other: _____  |

*K. L. Bell*

**Detailed Action**

**Objection to the Drawing**

The submitted photographic illustrations filed February 26, 2004 have been objected to under 35 CFR 1.165(a). By way of explanation, the photographic illustrations should not be mounted (37 CFR 1.84(e)).

The rules for submitting drawings, 37 CFR 1.84 and 37 CFR 1.165, were amended effective November 29, 2000. The USPTO delayed enforcement of these changes until October 1, 2001. Complete details can be found in the May 22, 2001 *Official Gazette* (1246 OG 106-107) or on the Internet at:

**<http://www.uspto.gov/web/offices/com/sol/og/2001/week21/patwavr.htm>**.

**Objection to the Disclosure**

**37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

**35 USC 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

### **Detailed Action**

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164 (reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C 161, the requirements of 35 U.S.C. 112 are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 35 CFR 1.163(a) and under 35 U.S.C. 112, first paragraph, because the specification presents less than a full, clear, and complete botanical description of the plant and the characteristics which define same per se and which distinguish the plant from related known cultivars and antecedents.

More Specifically:

**Detailed Action**

- A. Page 1, lines 16-19, and 34, Rather than stating "Pat." Applicants should state -- Patent-- to clearly set forth that a U.S. Plant Patent is being referred to.
- B. Page 1, line 27, "so" should be deleted as this recitation without this term is more than adequate.
- C. Page 1, lines 35 and 36, Applicants should delete "Omi R&D Center, Suntory Flowers Ltd." as this constitutes unwarranted advertising (MPEP 1610).
- D. Page 2, lines 10 and 11, Applicants should delete "Omi R&D Center of Suntory Flowers Ltd." as this constitutes unwarranted advertising (MPEP 1610).
- E. Page 2, lines 1-17, Applicants state pieces of an axillary bud were irradiated. Then elongated buds were grown from cuttings. This recitation is not understood as it is unclear how elongated buds originating from an axillary bud were grown from cuttings. Correction and/or clarification is necessary. Further, applicants state they selected a plant and propagated it by cuttings. The plants were then grown out and then finally selected a plant. This second recitation is not understood as applicants have stated they selected a plant and asexually reproduced it by

**Detailed Action**

cuttings. This appears to be the instant plant but then there is confusion when applicants state “The plants were then grown out and then finally selected a plant.”. It is not understood which is the instant plant. Also, Applicants do not state the manner and location in which this finally selected plant was asexually reproduced (MPEP 1605). The origin of the instant plant must be unambiguously set forth in the specification (MPEP 1605).

F. Page 2, lines 15 and 16, Applicants state the instant plant is “uniform and stable in its characteristics”. However, applicant does not state the instant plant reproduces true to type in successive generations of asexual reproduction. The instant plant must reproduce true to type in successive generations of asexual reproduction to obtain a U.S. Plant Patent. Correction and/or clarification is necessary.

G. Page 2, line 19, Applicants state “color-cording”. It appears applicants meant to state --color-coding--. Correction and/or clarification is necessary.

H. Applicants are requested to set forth in the specification whether the cultivars, ‘Sunrove’ and ‘Revolution hotpink marrose’, have been patented in the United States, is currently the subject of a pending U.S. Plant Patent application, or unpatented. If patented, --(U.S. Plant Patent No.)-- should be inserted after the cultivar name. If the subject of a pending application,

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such should be referred to by serial number. If unpatented, --(unpatented)-- should be inserted after the appropriate cultivar name.

I. Page 6, lines 21-29, Applicants should set forth in the specification the age of the plant when described and location of culture.

J. Page 7, lines 12-17, Applicants should set forth in the specification additional information relative to the instant plant's stem including the typical and observed stem length.

K. Page 7, line 15, Applicants state "Branching. – Many". Applicants should set forth in the specification the typical and observed number of branches per plant. The recitation "Many" is vague and insignificant in this instance.

L. Page 7, lines 18-26, Applicants should set forth in the specification additional information relative to the instant plant's leaves including the typical and observed margin descriptor.

M. Page 7, line 26, Applicants state the instant plant's leaves have "Normal" pubescence. The recitation "Normal" is not understood as it is unclear what applicants intend "Normal" to

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mean. Applicants should set forth in the specification a more proper description for the amount of pubescence present per leaf such as Sparse, Moderate, or Abundant. Correction and/or clarification is necessary.

N. Page 7, line 30, Applicants state shape of corolla tube is "Thick". "Thick" is not a shape. Applicants should set forth in the specification a proper shape descriptor for the instant plant's corolla tube.

O. Page 7, line 31, Applicants state "Shape of petal chip". The recitation "petal chip" is not understood as it is unclear what applicants intend "petal chip" to mean. Correction and/or clarification is necessary.

P. Applicants should set forth in the specification additional information relative to the instant plant's flower including the typical and observed flower depth, tube length and diameter, and throat diameter.

Q. Applicants should set forth in the specification additional information relative to the instant plant's petals including the typical and observed petal number, shape, length, width, and apex and margin descriptor.



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R. Page 7, lines 35 and 36, Applicants set forth a coloration but do not state whether the coloration is for the upper or lower petal surface. Applicants should set forth in the specification the coloration for the upper and lower petal surface with reference to the employed color chart.

S. Page 7, lines 36 and 37, Claim, and Abstract, Applicants state “Bottom color of the corolla throat”. It is not understood what the “Bottom” of the “corolla throat” is. Applicants should set forth in the specification a coloration for the flower throat with reference to the employed color chart.

T. Page 8, lines 1 and 2, Applicants should set forth in the specification a coloration for the inside of the flower tube with reference to the employed color chart.

U. Page 8, line 3, Applicants state “Normal”. The recitation “Normal” is not understood as it is unclear what applicants intend “Normal” to mean. Correction and/or clarification is necessary.

V. Page 8, lines 6 and 7, Applicants should set forth in the specification additional information relative to the instant plant’s peduncle including the typical and observed coloration with reference to the employed color chart.

**Detailed Action**

W. Applicants should set forth in the specification the lastingness of the bloom.

X. Applicants should set forth in the specification whether the instant plant's flower has a fragrance. If the instant plant's flower has fragrance it should be described in the specification.

Y. Applicants should set forth in the specification information relative to the instant plant's sepal including the typical and observed number, shape, length, width, apex and margin descriptor, and coloration (both surfaces) with reference to the employed color chart.

Z. Applicants should review the entire specification, Claim, and abstract for proper English sentence structure and spellings.

The above listing may not be complete. Applicants should carefully review the disclosure and import into same any corrected or additional information which would aid in botanically identifying and/or distinguishing the cultivar for which United States Plant Patent protection is sought.

**Detailed Action**

**Claim Rejection**

**35 U.S.C. 112, 1st & 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for the reasons set forth in the Objection to the Disclosure Section above.

**Future Correspondence**

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Kent L. Bell whose telephone number is (571) 272-0973. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

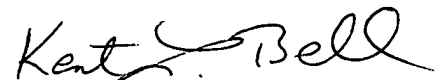
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached at (571) 272-0811.

The fax phone number for the group is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

K. L. Bell

**KENT BELL  
PRIMARY EXAMINER**

A handwritten signature in black ink that reads "Kent L. Bell". The signature is stylized, with the first name "Kent" and last name "Bell" clearly legible, and a middle initial "L." written in smaller script between them.